



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,812	05/14/2001	Kevin W. Smith	1001.1451103	8879
28075	7590	08/08/2005	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/854,812

Applicant(s)

SMITH, KEVIN W.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/13/01; 4/30/02; 3/25/02</u>   | 6) <input type="checkbox"/> Other: _____                                    |

It is noted that this application is a continuation of US Serial No. 09/369,724 filed August 6, 1999, now US Patent No. 6,235,026. The original paper filed with the application included an amendment canceling claim 1 and adding new claims 42-61. Applicant has also submitted on May 13, 2005 a copy of a transmittal letter filed on the filing date (May 14, 2001) that canceled claims 2-41. The instant Office action treats claims 42-61 as intended by applicant. Applicant's further response(s) should provide a copy of the pending claims, including an indication that claims 1-41 have been canceled, as is now the practice.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42-45, 47, 49-55, 57, 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Kozak et al (5,066,295).

Kozak et al disclose a rotatable surgical snare device comprising an elongate flexible sheath (28) having a flexible shaft (22) movable relative to the sheath. A snare (20) is coupled to the distal end of the shaft (22). A handle member (10) is coupled to the proximal end of the shaft, the handle member including a first handle (90) including a body and a knurled knob, wherein rotation of the first handle results in rotation of the shaft. A second handle (60) is also coupled to the shaft to provide longitudinal movement of the shaft. There is further a tubular sheath (132) coupling the first handle

Art Unit: 3739

member to the second handle member (see Figure 2), and the knob includes a bore (152, Figure 4c) having a non-circular cross section. There is also a means (44,46) for mounting the handle assembly (including the first handle portion) to an endoscope such that the shaft extends through the endoscope. There is also a means (120) for providing a cautery current to the shaft, and the second handle includes a stationary member (66) and a spool member (80) slidable relative to the stationary member to cause longitudinal member of the shaft.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47, 48, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozak et al ('295) in view of the teachings of Nakao et al (5,759,187) and Ouchi (6,117,141).

The examiner maintains that the Kozak et al device is inherently capable of being inserted into an endoscope, even though there is no express disclosure of such a use. Kozak et al also fail to disclose the specific mounting means that allows the distal end of the sheath to be adjustably fixed with respect to the endoscope.

The Nakao et al reference is cited to show the known use of snare devices within endoscopes (see Figures 41A-41E). As such, Nakao et al generally teach that it is known to provide snare devices through endoscopes to treat tissue. Regarding the

Art Unit: 3739

particular fixation means, Ouchi disclose a slidable fixation means (12) that allows a tubular instrument to be adjustably fixed to an endoscope. The examiner maintains that any known tubular instrument, such as a snare device, may be affixed to an endoscope using such a fixation element.

To have provided the Kozak et al device with a fixation means to allow the snare device to be adjustably fixed to an endoscope would have been an obvious modification for one of ordinary skill in the art in view of the teachings of Nakao et al and Ouchi.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,235,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specific use of a snare as the end-effector is deemed an obvious consideration for one of ordinary skill in the art.

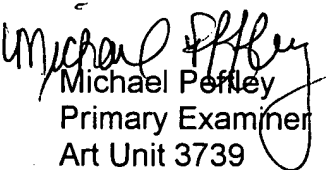
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chamness et al (3,955,578), Chamness (4,294,254) and Avellanet (WO 00/42926) all disclose various other snare devices that may also be rotated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
August 2, 2005